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OFFICE OF PETITIONS

In re Application of: :
Ryan :
Filed: 14 November, 2001 : **ON PETITION**
Application No. 09/992,301 :
Docket No.: 2089CON2 (203-2413 CON2) :

This is a decision on the renewed petition filed herein on 15 August, 2003, under 37 C.F.R. §1.137(b) to revive the above-identified application as abandoned due to unavoidable delay, and in light of the allegations (non-receipt of Office action) and the supplemental petition filed via FAX on 27 October, 2003, considered as a petition to withdraw the holding of abandonment under 37 C.F.R. §1.181.

For the reasons set forth below, the petition:

- as considered under 37 C.F.R. §1.181 to withdraw the holding of abandonment is **GRANTED**; and
- under 37 C.F.R. §1.137(b) is **DISMISSED as moot** and the fees (\$1,300.00) refunded via Treasury check.

BACKGROUND

The record indicates that:

- the instant application was deposited on 14 November, 2001, and a filing date was accorded, however, it appeared that Fig. 17 as referenced in the application was omitted from the materials deposited;
- the Office mailed a Notice of Omitted Items (referencing Fig. 17) on 6 December, 2001,

stating therein that "[t]he failure to file a petition (and petition fee) * * * will be treated as a constructive acceptance by the applicant of the application as deposited in the USPTO";

- on 15 February, 2002, Petitioner timely submitted (over a 6 February, 2002, certificate of mailing) a petition under 37 C.F.R. §1.182 to obtain the 14 November, 2001, filing date for Fig. 17;
- the Office mailed a Notice of Abandonment on 6 May, 2003;
- the petition under 37 C.F.R. §1.182 was dismissed on 23 August, 2002, for failing to satisfy statutory and regulatory requirements;
- Petitioner replied to the Notice of Abandonment on 18 August, 2003, with the petition under 37 C.F.R. §1.137(b), but also submitted therewith copies of the 15 February, 2002, reply timely submitted (over the 6 February, 2002, certificate of mailing) to the Notice of Omitted Items, and so evidenced an argument that the holding of abandonment was improper and should be withdrawn;
- on 27 October, 2003, Petitioner formalized with an express request to withdraw the holding of abandonment the argument that the holding of abandonment was improper.

As noted above, the reply to the Notice of Omitted Items was timely submitted.

Moreover, as discussed below, a reply to a Notice of Omitted Items is not required.

STATUTES, REGULATIONS AND ANALYSIS

Congress has authorized the Commissioner to "revive an application if the delay is shown to the satisfaction of the Commissioner to have been "unavoidable." 35 U.S.C. §133 (1994).¹

The regulations at 37 C.F.R. §1.137(a) and (b) set forth the requirements for a petitioner to revive a previously unavoidably or unintentionally, respectively, abandoned application under this congressional grant of authority. The language of 35 U.S.C. §133 and 37 C.F.R. §1.137(a) is clear, unambiguous, and without qualification: the delay in tendering the reply to the outstanding Office action, as well as filing the first petition seeking revival, must have been unavoidable for

¹ 35 U.S.C. §133 provides:

35 U.S.C. §133 Time for prosecuting application.

Upon failure of the applicant to prosecute the application within six months after any action therein, of which notice has been given or mailed to the applicant, or within such shorter time, not less than thirty days, as fixed by the Commissioner in such action, the application shall be regarded as abandoned by the parties thereto, unless it be shown to the satisfaction of the Commissioner that such delay was unavoidable.

the reply now to be accepted on petition.²

Delays in responding properly raise the question whether delays are unavoidable.³ Where there is a question whether the delay was unavoidable, Petitioners must meet the burden of establishing that the delay was unavoidable within the meaning of 35 U.S.C. §133 and 37 C.F.R. §1.137(a).⁴ And the Petitioner must be diligent in attending to the matter.⁵ Failure to do so does not constitute the care required under Pratt, and so cannot satisfy the test for diligence and due care.

By contrast, unintentional delays within the meaning of 35 U.S.C. §41(a)(7) and 37 C.F.R. §1.137(b) are those that do not satisfy the very strict statutory and regulatory requirements of unavoidable delay, and also, by definition, are not intentional.⁶

Discussion of the proper alternative replies to a Notice of Omitted Items regarding a drawing--including the proper alternative of not replying to said Notice--is set out in the commentaries of the Manual of Patent Examining Procedure (MPEP) at MPEP §601.01(g), which provides in pertinent part:

An applicant willing to accept the application as deposited in the USPTO need not respond to the "Notice of Omitted Item(s)." and the failure to file a petition under 37 C.F.R. §1.53(e) or 37 C.F.R. §1.182 with the required petition fee as discussed above within 2 months of the date of the "Notice of Omitted Item(s)" (37 C.F.R. §1.181(f)) will be treated as constructive acceptance by applicant of the application as deposited in the USPTO. (Emphasis supplied.)

Allegations as to the Request to Withdraw
the Holding of Abandonment and
the Petition Alleging Unintentional Delay

The courts have determined the construct for properly supporting a petition seeking withdrawal

² Therefore, by example, an unavoidable delay in the payment of the Filing Fee might occur if a reply is shipped by the US Postal Service, but due to catastrophic accident, the delivery is not made.

³ See: *Changes to Patent Practice and Procedure; Final Rule Notice*, 62 Fed. Reg. at 53158-59 (October 10, 1997), 1203 Off. Gaz. Pat. Office at 86-87 (October 21, 1997).

⁴ See: *In re Application of G*, 11 USPQ2d 1378, 1380 (Comm'r Pats. 1989).

⁵ See: *Diligence in Filing Petitions to Revive and Petitions to Withdraw the Holding of Abandonment*, 1124 Off. Gaz. Pat. Office 33 (March 19, 1991). It was and is Petitioner's burden to exercise diligence in seeking either to have the holding of abandonment withdrawn or the application revived. See 1124 Off. Gaz. Pat. Office *supra*.

⁶ Therefore, by example, an unintentional delay in the reply might occur if the reply and transmittal form are to be prepared for shipment by the US Postal Service, but other pressing matters distract one's attention and the mail is not timely deposited for shipment.

of a holding of abandonment.⁷

Petitioner contends and evidences that--although it was not required--he replied timely and properly to the Notice of Omitted Items, and the Office indeed received and acted on that reply, albeit with a dismissal. Therefore, Petitioner satisfies the requirements for having the holding of abandonment withdrawn.

Petitioner's attention is directed to the requirement also discussed at MPEP §601.01(g) for the applicant to file an amendment to cancel all references to the omitted drawing/figure.

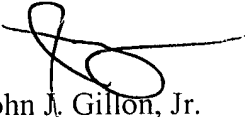
CONCLUSION

Accordingly, Petitioner satisfied the burdens set forth in Delgar v. Schulyer, and the petition under 37 C.F.R. §1.181 hereby is **granted** and the 5 May, 2003, Notice of Abandonment is vacated.

The petition herein under 37 C.F.R. §1.137(b) is **dismissed as moot**.

The instant application is forwarded to OIPE for further processing as necessary before being examined in due course.

Telephone inquiries concerning this decision may be directed to the undersigned at (703) 305-9199.



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Office of Petitions

⁷ See: Delgar v. Schulyer, 172 USPQ 513 (D.D.C. 1971).